

## REMARKS/ARGUMENTS

In the Office Action mailed June 30, 2010, claims 1-17 were rejected. In response, Applicant hereby requests reconsideration of the application in view of the amendments and the below-provided remarks. No claims are added or canceled.

For reference, claims 10-17 are amended to replace the references to “means” with corresponding structural embodiments supported by the subject matter described in the specification. In particular, the claims recite a computer processing device instead of the computer means, the checking means, and the modification means. The claims also recite a storage device instead of the storage means. These amendments are supported by the subject matter described in the specification, which describes the computer means as a device for running a software program and the storage means as a device for storage various types of data.

### Priority

The Office Action requests that a reference to the prior international application be provided in the first sentence of the specification or in an application data sheet (ADS). However, MPEP 1893.03(c) explicitly states that “it is not necessary for the applicant to amend the first sentence(s) of the specification to reference the international application number” that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage” (emphasis added). The reasoning presented in the MPEP further explains that “a national stage application submitted under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the international filing date of the international application.” MPEP 1893.03(c). Therefore, Applicant respectfully declines to amend the specification as suggested.

### Objections to the Claims

The Office Action objects to claims 2-9, 11-15, and 17. Apparently, this objection relies on the use of “A” instead of “The” in the preamble of the dependent

claims. However, there is no basis in the statutes or the regulations for this objection. In fact, MPEP 608.08(n) provides various examples of claims which are designated as acceptable and use either “A” or “The” in the preamble of dependent claims. Thus, the MPEP explicitly acknowledges that it is acceptable to use “A” in the preamble of dependent claims. Accordingly, Applicant respectfully requests that the indicated claim objections be withdrawn.

#### Claim Rejections under 35 U.S.C. 112

Claims 10-15 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, these claims are rejected for recited “means” that purportedly are not clearly linked or associated in the specification with corresponding structure. Applicant notes that these claims (as well as claims 16 and 17) are amended to remove the references to “means” and refer to specific structural components. Accordingly, Applicant respectfully requests that the rejections of claims 10-15 under 35 U.S.C. 112, second paragraph, be withdrawn.

#### Claim Rejections under 35 U.S.C. 103

Claims 1-17 were rejected based on one or more cited references. The cited reference(s) relied on in these rejections include:

Everett et al. (U.S. Pat. Pub. No. 2002/0050528, hereinafter Everett)

Richards et al. (U.S. Pat. No. 6,230,267, hereinafter Richards)

Kawano et al. (U.S. Pat. No. 6,899,277, hereinafter Kawano)

In particular, claims 1-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Everett in view of Richards and in view of Kawano. Claims 10, 11, 16, and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Richards and in view of Kawano. Claims 12-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Richards in view of Kawano and in view of Everett. However,

Applicant respectfully submits that these claims are patentable over Everett, Richards, and Kawano for the reasons provided below.

#### Independent Claim 1

Claim 1 is patentable over the combination of Everett, Richards, and Kawano because the articulated reasoning in the Office Action is insufficient to support a *prima facie* case of obviousness for the claim. Claim 1 recites:

A granting method to grant a modification device a modification right to modify an application in a data carrier, the method comprising:

generation of a first key information item and of an associated second key information item for a data carrier identified by a data carrier identification information item;

generation of a first master key information item and an associated second master key information item in addition to the first key information item and the associated second key information item;

checking of the association of the first key information item stored in the data carrier with the second key information item from the modification device;

allowing of the modification of the application in the data carrier by the modification device in response to a determination that the first key information item is associated with the second key information item;

checking of the association between the first master key information item stored in the data carrier with the second master key information item from the modification device; and

allowing a modification by the modification device of access rights to at least one interface of the data carrier in response to a determination that the first master key information item is associated with the second master key information item.

(Emphasis added.)

For reference, the reasoning in the Office Action acknowledges that Everett does not teach checking the association of the first key information item stored in the data carrier with the second key information item from the modification device. Hence, the reasoning in the Office Action relies on the proposed combination of teachings of Richards with Everett. However, the proposed combination of teachings of Richards with Everett is improper because the proposed combination of teachings is incompatible with the explicit teachings of Everett.

In order to establish a *prima facie* rejection of a claim under 35 U.S.C. 103, the Office Action must present a clear articulation of the reason why the claimed invention would have been obvious. MPEP 2142 (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007)). The analysis must be made explicit. *Id.* Additionally, rejections based on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Thus, there are at least three criteria that must be satisfied in order to establish a *prima facie* case of obviousness:

- 1) The rejection must include a conclusion that the claimed invention would have been obvious.
- 2) The rejection must include articulated reasoning to support the asserted conclusion of obviousness.
- 3) The articulated reasoning must be based on some rational underpinning.

In light of the analysis presented below, Applicant submits that the reasoning Office Action does not establish a *prima facie* rejection of the claim because the articulated reasoning is not based on a rational underpinning. In particular, the reasoning in the Office Action is not based on a rational underpinning because the assertions in the Office Action are incompatible with the actual teachings of Everett.

With reference to the indicated language of the claim, the reasoning in the Office Action acknowledges that Everett does not teach checking the association of the first key information item with the second key information item. Office Action, 6/30/10, page 6. The reasoning in the Office Action merely relies on Everett as generally teaching “checking the identification personalization data.” Office Action, 6/30/10, page 6. In the absence of specific teachings in Everett, the reasoning in the Office Action attempts to combine teachings of Everett to suggest that “checking the identification personalization data” might include “checking of the association of the first key information item stored in the data carrier with the second key information item from the modification device.” For reference, the description in paragraphs 55-59 of the personalization bureau (PB) of

Everett is relied on as purportedly teaching a modification device. However, the reasoning in the Office Action fails to acknowledge that Everett specifically states that the PB of Everett “never obtains knowledge of the content of the data blocks transferred” (Everett, paragraph 40, emphasis added), which includes the individual key set for the card. In other words, the PB of Everett never knows what the individual key set of the card is. Therefore, Everett cannot be modified to suggest that the PB might be involved in providing the keys for the “checking” operations because the PB does not have any knowledge of the key set that is stored on the card. Moreover, to the extent that PB might be involved in initially loading the key set onto the card during the initial card enablement process, the PB does not provide a second key—or, in other words, there is not a second key from the modification device—within the context of a process for checking an association of the first key information item stored in the data carrier with the second key information item from the modification device.

Additionally, as a separate basis for showing that the Office Action does not establish a *prima facie* case of obviousness, it should be noted that the assertions in the Office Action do not include a conclusion that it might have been obvious to modify access rights to at least one interface of the data carrier in response to a determination that the first master key information item is associated with the second master key information item. Rather, the Office Action merely makes separate and distinct assertions regarding modifying access to a data carrier, generally (based on the teachings of Richard), and modifying an interface of a data carrier (based on the teachings of Kawano). There is no assertion that it might have been obvious to modify access rights to at least one interface of the data carrier in response to a determination that the first master key information item is associated with the second master key information item. In other words, there is no assertion or conclusion to correlate the separate and distinct teachings of 1) modifying access to a data carrier in response to checking an association between master keys, and 2) modifying an interface of a data carrier. The conclusion that the teachings of modifying an interface of a data carrier might be combined into one embodiment with the separate teachings of modifying access to a data carrier in response to checking an association between master keys simply does not state the conclusion that the access rights to at least one interface of the data carrier might be modified in response

to a determination that the first master key information item is associated with the second master key information item.

Moreover, since Richard already teaches (according to the Office Action) modifying access to a data carrier, generally, in response to a determination related to master keys, and Kawano already teaches a way to switch between contact and non-contact interfaces without checking master keys, there is no reason to make the functionality of Kawano dependent on the separate determinations of Richard. If the data carrier access is already dependent on checking the master keys, then such functionality should be sufficient to control unauthorized access, without any need to further make the interface controls dependent on the same checking of the master keys. Rather, repeating the checking functionality for otherwise separate reasons would simply introduce complexity and costs of unnecessarily redundant checking, when the single checking functionality of Richard is apparently sufficient.

For the reasons presented above, the proposed combination of Everett, Richards, and Kawano is improper and does not establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully asserts claim 1 is patentable over the proposed combination of Everett, Richards, and Kawano because the combination of cited references is improper.

#### Independent Claims 10 and 16

Applicant respectfully asserts independent claims 10 and 16 are patentable over the cited references at least for similar reasons to those stated above in regard to the rejection of independent claim 1. Each of these claims recites subject matter which is similar to at least some of the subject matter of claim 1 discussed above. Although the language of these claims differs from the language of claim 1, and the scope of each claim should be interpreted independently of other claims, Applicant respectfully asserts that the remarks provided above in regard to the rejection of claim 1 also apply to the rejections of these claims.

### Dependent Claims

Claims 2-9, 11-15, and 17 depend from and incorporate all of the limitations of the corresponding independent claims 1, 10, and 16. Applicant respectfully asserts these dependent claims are allowable based on allowable base claims. Additionally, each of these dependent claims may be allowable for further reasons.

### **CONCLUSION**

Applicant respectfully requests reconsideration of the claims in view of the amendments and the remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-4019** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **50-4019** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

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